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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Carpenter et al.
Serial No: 09/498,950
Filed: February 4, 2000
For: ADJUSTABLE BINDING STRAP FOR SECURING A
SNOWBOARDING BOOT TO A BASEPLATE
Examiner: Vanaman, F.
Art Unit: 3611

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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to Commissioner for Patents, Washington, D.C. 20231, on April 19, 2002.

Signature

Commissioner for Patents
Washington, D.C. 20231

RESPONSE

Sir:

In response to the Office Action mailed October 24, 2001, Applicants respectfully request reconsideration.

Claim Rejections Under 35 U.S.C. §102

Claims 1, 2, 5-7, 10-13, 17-19, 22, 23, 26-28, 36-38, 42-46, 48-50, 56, 60, 62-65, 67-70, 74-80, 82-85 are rejected under 35 U.S.C. §102(e) as being anticipated by Shields (U.S. Patent No. 6,293,577, filed October 3, 1996).

Applicants enclose the declarations of inventors Christopher Doyle and Jake Carpenter under 37 C.F.R. 1.131 to establish invention of the subject matter of the rejected claims prior to the effective date of the Shields patent. Accordingly, the rejection of the claims 1, 2, 5-7, 10-13, 17-19, 22, 23, 26-28, 36-38, 42-46, 48-50, 56, 60, 62-65, 67-70, 74-80, 82-85 under 35 U.S.C. §102(e) as being anticipated by Shields should be withdrawn.

Claim Rejections Under 35 U.S.C. §103

Claim 85 is rejected under 35 U.S.C. §103 as being unpatentable over Bumgarner (U.S. Patent No. 5,758,895). This rejection is respectfully traversed.

The Office Action states that Bumgarner teaches all of the claimed elements except for the reversal of the roles of the first and second straps, such that an end of the second strap may be inserted through the end of the first strap. The Office Action concludes, "it would have been obvious to one of ordinary skill in the art at the time of the invention to reverse the location of the mating notches and lock taught by Bumgarner for the purpose of simplifying the manufacture of the individual strap component 4, such that it does not require a locking device."

The Office Action fails to set forth a *prima facie* case of obviousness because the proposed modification, namely reversing the location of the mating notches and the lock, would render the strap inoperable for its intended purpose. In addition, one of skilled in the art would not have been motivated to modify Bumgarner because there is no apparent problem with the Bumgarner straps. In this respect, the motivation to modify the Bumgarner strap requires a desirability to make the modification, not merely a trade-off. The mere fact that the prior art may be modified in the manner suggested does not make the modification obvious.

First, assuming that the lock 41 could be mounted to the toothed strap of Bumgarner, it is respectfully submitted that the end of the strap 4 could not be inserted into the opening of the lock. Reference is made to Fig. 3 of Bumgarner wherein it is clear that the padded strap portion 4 has a greater width than the width of the lock 41 such that the end of the strap 4 could not be inserted into the opening in the lock 41. In addition, the padded strap 4 has a thickness that appears to be much greater than the thickness of the opening of the lock, again prohibiting insertion of the strap 4 into the lock 41. Further, the padded strap portion 4 does not include ratchet teeth such that it could not cooperate with the lock 41 to secure the straps together.

Second, the Office Action states that the reason one would have been motivated to modify Bumgarner is to "simplify the manufacture of the individual strap component 4". Nothing in the prior art suggests that the manufacturing complexity of the strap 4 is unacceptable. Thus, there would have been no reason to modify it. In addition, to "simplify the manufacture" of the strap 4, one of skill in the art would need to increase the complexity of the toothed strap by mounting the lock 41 to its end and modifying the end of the padded strap 4 so that it can be inserted in and locked to the lock 41. Such modifications, at best, would render the manufacturing complexity neutral and, more likely, *increase* the complexity, such that, either way, one of skill in the art simply would not have been motivated to make the suggested modification. In sum, the manufacturing complexity of strap 4 is tolerable -- any proposed

modification to reduce its complexity would be overshadowed by the increase in the manufacturing complexity of the other components, rendering the reason for the modification articulated in the Office Action doubtful.

Therefore, it is respectfully submitted that the Office Action fails to set forth a *prima facie* case of obviousness because modifying the strap of Bumgarner in the manner suggested would render the strap unsatisfactory for its intended purpose and increase the manufacturing complexity. Accordingly, the rejection of claim 85 under 35 U.S.C. §103(a) as being unpatentable over Bumgarner should be withdrawn.

CONCLUSION

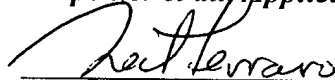
In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

Carpenter et al. Applicants

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